

### **REMARKS/ARGUMENTS**

These remarks are submitted in response to the office action dated September 7, 2005 (Office Action). As this response is timely filed before the expiration of the 3-month shortened statutory period, no fee is believed due.

Claims 13, 14, 20-23, 33, 35, 36, 49, 50, 56, 57, 58 and 59 were rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2005/0059400 to Jagadeesan, *et al.* (hereinafter Jagadeesan). Claims 1-4, 7, 9, 11, 12, 31, 32, 37-40, 43, and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0134636 to Sundar, *et al.* (hereinafter Sundar) in view of U.S. Published Patent Application No. 2004/0087307 to Ibe, *et al.* (hereinafter Ibe). Claims 5 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Ibe and further in view of U.S. Published Patent Application No. 2004/0090937 to Chaskar, *et al.* (hereinafter Chaskar). Claims 6 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Ibe and Chaskar and further in view of U.S. Published Patent Application No. 2004/0159153 to Mousseau, *et al.* (hereinafter Mousseau). Claims 8 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Ibe and further in view of Jagadeesan. Claims 10, and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Ibe and further in view of U.S. Patent No. 6,308,066 to Ranta, *et al.* (hereinafter Ranta). Claims 15-17, 34, and 51-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2005/0070288 to Belkin, *et al.* (hereinafter Belkin) in view of Chaskar. Claims 19 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Belkin in view of Chaskar and further in view of Mousseau. Claims 24, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Belkin in view of U.S. Published Patent Application No. 2004/0249891 to Khartabil, *et al.* (hereinafter Khartabil). Claims 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Khartabil and further in view of Ibe. Claims 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sundar in view of Khartabil, Ibe and Chaskar. Claims 27-28 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Sundar in view of Khartabil, Ibe, Chaskar, U.S. Patent No. 5,845,211 to Roach, Jr. (hereinafter Roach) and U.S. Published Patent Application No. 2004/0203788 to Fors, *et al.* (hereinafter Fors).

In response, Applicants have amended independent Claims 1, 7, 31, 32, 37, and 43 to emphasize certain aspects of Applicants' invention. Applicants have cancelled Claims 10 and 46 to maintain consistency among the claims. The amendments are fully supported throughout the Specification. (See, e.g., Specification,

**I. Claims 1, 7, 31, 32, and 43, As Amended. Define Over The Prior Art**

Independent Claims 1, 31, and 37 were rejected as anticipated by the combination of Sundar and Ibe. Neither Sundar nor Ibe, however, teaches or suggests the comparing of relative strengths of signals from a wireless network and from a cellular network. Accordingly, neither reference, alone or in combination, can base a determination of whether to handoff a call between networks on such a comparison. Applicants respectfully submit, therefore, that Sundar and Ibe, alone and in combination, fail to teach every feature recited in amended independent Claims 1, 31, and 37.

At page 4 of the Office Action, it is asserted that Jagadeesan discloses a method of roaming between a cellular network and a wireless network wherein the method includes the step of comparing a measure of strength of the signal received from the cellular network with a measure of the strength of a signal received from the wireless network. As pointed out in the following section, however, Applicants' invention predates the effective date of Jagadeesan. Applicants respectfully submit that Jagadeesan, therefore, can not be asserted against Applicants' invention and that Claims 1, 31, and 37 thus define over the prior art. Applicants further respectfully submit that whereas dependent Claims 2-6 and 38-42 each depend from one of amended independent Claims 1, 31, or 37, while reciting additional features, these dependent claims likewise define over the prior art.

Independent Claims 7, 32, and 43 were also rejected as being unpatentable over Sundar in view of Ibe. Neither Sundar nor Ibe, however, teaches or suggests initiating a handoff that switches an established call from a cellular network to a wireless network, wherein the initiating includes attenuating a signal provided to the cellular network from the mobile communications device so as to cause the cellular network to effect a handoff the cellular call, as recited in each of independent Claims 7, 32, and 43, as amended.

Ranta, cited at page 21 of the Office Action, discloses certain conditions under which a call handover in a cellular network has a high probability of occurring: when there is a long distance between a mobile station and the base station; when signal attenuation on the radio path from the base station is high; when the signal strength from neighbor base stations starts to increase, or when a mobile station moves at high speed. But this passage merely describes underlying conditions – physical principles – that influence the likelihood of a handover. Nothing in the passage, however, teaches or suggests an application of these physical principles as taught by Applicants' invention.

Specifically, Ranta's enumeration of existing conditions that affect the probability of a handover do not teach or suggest initiating a handoff by actively intervening to cause the attenuation of a signal. More fundamentally, Ranta suggests nothing about actively intervening to cause a signal attenuation that effects a handoff for switching a mobile communications device from a cellular network to a wireless network. As is generally true, Ranta's reiteration of known underlying physical principles suggests nothing about applying a principle to achieve the specific result achieved with Applicants' invention. Applicants respectfully submit, therefore, that independent Claims 7, 32, and 43 define over the prior art. Applicants respectfully submit further that whereas dependent Claims 8-12, 44-48 each depend from one of these amended independent claims, these dependent claims likewise define over the prior art.

## **II. Applicants' Invention Predates Belkin, Jagadeesan, and Mousseau**

Each rejection of independent Claims 13, 15, 20, 22, 24, 33-36, 49, and 51 was based on Jagadeesan or some combination of Belkin and/or Mousseau. In response, Applicants respectfully assert that they conceived of their invention and actively pursued its reduction to practice from a time prior to the September 12, 2003, the September 29, 2003, and the November, 20, 2003, effective dates of Jagadeesan, Belkin, and Mousseau, respectively.

Applicants thus respectfully maintain that Jagadeesan, Belkin, and Mousseau can not be applied against Applicants' invention. In support of their assertion, Applicants herewith submit their Declarations along with evidence of activity on specific dates that establishes conception and continuing diligence from a time prior to the effective dates of each of Jagadeesan, Belkin, and Mousseau.

The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2003-0051 (Disclosure) entitled "Cellular 802.11 Voice Roaming Utilizing SIP Signaling." The Disclosure was submitted by Applicants on March 25, 2003, to an IP professional employed by the assignee of the invention, International Business Machines Corporation (IBM). The disclosure was revised by Applicants on March 27, 2003. The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as March 27, 2003, which predates the effective dates of each of Jagadeesan, Belkin, and Mousseau.

The Disclosure is an IBM confidential disclosure form. It is a standardized document utilized, according to established IBM procedures, by IBM inventors upon their conception of an invention. The procedures established by IBM govern the internal use of the confidential disclosure forms. One aspect of IBM's procedures governing the use of the confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after its submission to an IBM Attorney/Patent Professional. Any such changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added.

The present application, including each claim, was prepared based upon Applicants' Disclosure attached hereto. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the application prior to its submission to the U.S. Patent and Trademark Office to ensure that the claims and material contained therein were fully supported by the Disclosure.

The Disclosure provided the basis of each of the claims in the application. The text and figures of the Disclosure explicitly describe each aspect of Applicants' invention recited in each of the claims. (See, especially, p.3; see also Figure 1 at p. 3.) For example, the Disclosure describes the sending of an invitational signal, signal-based authentication, conditions for call hand-off, and the comparing of relative signal strengths.

Applicants exercised due diligence from prior to the effective dates of Jagadeesan, Belkin and Mousseau through to the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declarations, once an IBM disclosure form is completed, the disclosure is reviewed by an internal Invention Review Board (the Board) within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon the Board's reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. Outside counsel prepares a draft of the application that is reviewed by each inventor. The inventors, according to this standard procedure, must be satisfied that the application sufficiently details the inventive concepts described in the Disclosure.

Consistent with these established procedures, during the period between March 27, 2003, and December 15, 2003, an outside search firm conducted an initial patent search, the Board assigned the application to outside counsel, and outside counsel drafted the present application. The draft application prepared by outside counsel was reviewed by the inventors, with whose input the application was finalized in its submitted form. This activity of reviewing a patent application is consistent with the exemplary activities noted as satisfying the legal requirements

for a showing of diligence. *See, e.g.*, MPEP 715.07(a). Evidence of these activities are presented in Composite Exhibit "A," attached hereto:

1. Confidential invention search results sent to IBM on June 16, 2003, and marked as received on June 17, 2003;
2. Correspondence from IBM to outside counsel on June 20, 2003, instructing outside counsel to prepare and file Application;
3. Correspondence from outside counsel to IBM on June 24, 2003, confirming assignment;
4. E-mail correspondence from outside counsel to inventors on October 29, 2003, forwarding a draft of the Application;
5. E-mail correspondence from outside counsel to inventors on November 11, 2003, forwarding the final draft Application;
6. Facsimile correspondence from the IBM IP Law Department to outside counsel on November 25, 2003, forwarding the signed formal papers for filing the Application.

Consistent with professionally-accepted practices, outside counsel prepares cases on a "first come, first served" basis, though applications associated with bar dates are granted priority within the work queue. As proof that the present application was included within the work queue and receiving attention therein, Applicants have the electronic docket sheet titled "Actions Due" which shows a "Date Created" of July 8, 2003, and is attached hereto as Exhibit "B."

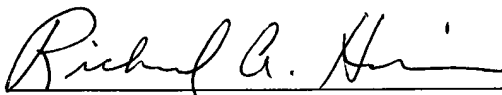
Applicants respectfully submit that the evidence convincingly establishes reasonable diligence from a time prior to the effective dates of Jagadeesan, Belkin and Mousseau to the filing date of the present Application. Accordingly, Applicants respectfully maintain that when coupled with the evidence of conception, the evidence of Applicants' diligence effectively removes Jagadeesan, Belkin and Mousseau from consideration against Applicants invention and, therefore, each of the claims defines over the prior art.

**CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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